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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,238	04/10/2006	Nercivan Kerimovska	9342-98	9239

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EXAMINER

JACKSON, JAKIEDA R

ART UNIT	PAPER NUMBER
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2626

MAIL DATE	DELIVERY MODE
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10/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/539,238	Applicant(s) KERIMOVSKA ET AL.	
	Examiner Jakieda R. Jackson	Art Unit 2626	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-7, 9-35, 37 and 39.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____.

Continuation of 3. NOTE: Applicant argues that the finality of the present action is improper. In particular, Applicants submit that several of the pending claims have not been amended, yet have been rejected based on the newly cited art, in contrast with the requirements of section 706.07(a) of MPEP. For example, claims 20-35 and 37 were not amended in Applicant's previous response of July 25, 2007, but have been rejected on new grounds based on Kirby. Likewise, Claim 39 was not amended in Applicants' previous response, but stand rejected on new grounds based on Ryu. Thus, Applicant's submit that the new grounds of rejection based on Kirby and Ryu were not necessitated by amendments in claims 20-35, 37 and/or 39. However, Applicant's arguments are not persuasive. After carefully reviewing the previous office actions and claim amendments, there was a Non-final office action dated 12/1/06 in which claims 1-37 were rejected under Freeland. Applicants submitted an amendment filed 3/2/07 in which Applicants amended independent claim 1, independent claim 20 remained the same and independent claim 39 was newly added. The Examiner could have introduced a new grounds of rejection to independent claims 1 and 39, but not 20, since new grounds of rejection would have been necessitated by the amendment. However, according to the Final office action mailed 5/25/07, independent claims 1, 20 and 39 were rejected under the same art (Freeland). After further reconsideration (Final Action dated 8/03/07), the Examiner rejected claims 1 and 39 under a new grounds of rejection. That being, claim 39 under Ryu and claim 1 under Freeland in view of Kirby, which were all previously amended claims. Claim 20 was interpreted and rejected for the same reasons as set forth in claim 1, however, notice that claim 1 was rejected under Freeland in view of Kirby based on the amendment, but claim 20, does not include that amendment, therefore, should have been headed differently. Freeland, which was used in all of the previous office actions, was used for claim 20 throughout the prosecution and does not require the new prior art Kirby. Therefore, independent claims 1 and 39 necessitated a new grounds of rejection based on the amendment and therefore they are at the same stage that they would have been after the amendment of filed on 3/2/07.

Regarding claim 39, Applicants argue that nowhere does the cited portion of Ryu disclose or suggest that the mobile telephone headset includes a speech generating device built into the mobile phone, as amended. This would require further reconsideration under the art of 102/103.

Regarding claim 1, Applicants argue that Kirby describes that the controller is configured to control scrolling based on the rate of speech, not converting text into speech based on the rate of scrolling. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., converting text into speech based on the rate of scrolling) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argues that Kirby teaches away from claim 1. In particular, Kirby relates to visually displaying text to be spoken while some embodiments of the present invention provide text-to-speech conversion "for the visually impaired and for users who need to focus on other things while using the phone. In other words, Kirby is directed to providing text based on speech, Applicants submit that Kirby teaches away from providing speech from text. However a prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness; however, "the nature of the teaching is highly relevant and must be weighted in substance. A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).... The court held the claims would have been obvious over prior art because the reference taught epoxy resin based material was useful for applicant's purpose, applicant did not distinguish the claimed epoxy from the prior art epoxy, and applicant asserted no discovery beyond what was known in the art. Furthermore, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed..." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). Arguments that alleged anticipatory prior art teaches away from the invention is not germane to a rejection under section 102. A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference teaches away from the invention is inapplicable to an anticipation analysis.

10/16/07

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